UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,142	09/16/2003	David A. Krise	FL12-052	7771

39279 7590 01/24/2008

Gregory IPL, P.C.
601 W. Main, Suite 904
SPOKANE, WA 99201-3825

EXAMINER	
LIM, SENG HENG	
ART UNIT	**PAPER NUMBER**
3714	

MAIL DATE	DELIVERY MODE
01/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/713,142	KRISE ET AL.	
	Examiner	Art Unit	
	Seng H. Lim	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/10/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19, 28, 37, 46 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The use of a multiplier was not described in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-15, 17, 20, 22-24, 26, 29, 31-33, 35, 38, 40-42, 44, 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker et al (US 5016879).

Re claim 13, 22, 31, 40. Parker et al discloses an apparatus for gaming, comprising: a playing field (30A, 30B, 30C: Fig. 3); at least one visible playing element such as a disk or ball (50: Fig. 3) that moves across the playing field from an introduction position toward a plurality of detection positions (4:50-60); at least one maze upon the playing field that affects the movement of the at least one visible playing

element upon the playing field (40: Fig. 3); a plurality of detection position displays that are controllable to display a plurality of symbols and at least one symbol selector for assigning symbols to the plurality of detection of position displays(60: Fig. 4); a payline display showing a combination of symbols that changes with each play of the gaming apparatus (62, 64, 66: Fig. 3); and wherein a bonus is awarded based upon at least one particular symbols shown on the payline display in combination with at least one detection position symbol of at least one particular type shown on at least one detection position display which is associated with a detection position that receives at least one visible playing element for detection thereby (5:3-25).

Re claim 14, 23, 32, 41. At least one deflector which affects the movement of the at least one visible playing element upon the playing field (40: Fig. 3).

Re claim 15, 24, 33, 42. At least one zone deflector which affects the movement of the at least one visible playing element upon the playing field (79: Fig. 5).

Re claim 17, 26, 35, 44. Comprising plurality of zone deflectors which can affect the movement of the at least one visible playing element upon the playing field (79: Fig. 5)

Re claim 20, 29, 38, 47. At least one zone wall which divides the playing field into multiple zones such as 30A, 30B and 30C (Fig. 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 16, 18, 21, 25, 27, 30, 34, 36, 39, 43, 45, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al (US 5016879) as applied to claims 13, 22, 31 and 40 above, and further in view of Yokoi (US 4508336).

Parker et al teaches the basic claimed apparatus as set forth above.

Parker et al does not disclose the zone deflector being selectable by a player playing the apparatus and affects the movement of the at least one visible playing element upon the playing field.

Yokoi disclose a vane/zone deflector being selectable by a player playing the apparatus and affects the movement of the at least one visible playing element upon the playing field (Fig. 1). Parker et al and Yokoi are analogous art because they are from the same field of endeavor of affecting the movement of a ball with the use of deflectors in a gaming machine. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Parker's apparatus to include a selectable zone deflector and would have been motivated to do so to increase the excitement of the game by allowing the players more control of the ball movement.

Claims 19, 28, 37, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al (US 5016879) as applied to claims 13, 22, 31 and 40 above, and further in view of Pierce et al (US 6047963).

Parker et al teaches the basic claimed apparatus as set forth above.

Parker et al does not disclose the detection position symbol of a particular form is a multiplier symbol that multiplies to determine a bonus award being made by the apparatus.

Pierce et al discloses a detection position symbol of a particular form is a multiplier symbol that multiplies to determine a bonus award being made by the apparatus (250M, 260M: Fig. 3). Parker et al and Pierce et al are analogous art because they are from the same field of endeavor of affecting the movement of a ball with the use of deflectors in a gaming machine. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Parker's apparatus to include a multiplier symbol that multiplies to determine a bonus award and would have motivated to do so to increase player's excitement by allowing them to have a chance of winning more.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13, 22, 31, 40 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,15, 16 and 17 of U.S. Patent No. 6419226 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a gaming machine or apparatus comprising of a playing field; a visible element; at least one maze or deflector pegs affecting the movement of the visible element; plurality of detection position displays; symbol selector for assigning symbols; a payline display and a bonus award based upon particular symbols shown on the payline display.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached USPTO form PTO-892.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seng H. Lim whose telephone number is 571-270-3301. The examiner can normally be reached on 8:30-6:00, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SHL

January 17, 2008

XUAN M. THAI
SUPERVISORY PATENT EXAMINER